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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,695	07/17/2000	John M. Connell	H053336.0001US1	9073
1200	7590	09/09/2004	EXAMINER	
AKIN, GUMP, STRAUSS, HAUER & FELD 1111 LOUISIANA STREET 44TH FLOOR HOUSTON, TX 77002			JONES, HUGH M	
			ART UNIT	PAPER NUMBER
			2128	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/617,695

### Applicant(s)

CONNELL ET AL.

### Examiner

Hugh Jones

### Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/4/2002</u>   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Claims 1 of U. S. Application 09/617,695, filed 07/17/2000, which is a continuation of 07/474,682 (now US Patent 6,101,324).

#### **Response to Amendment**

2. The preliminary amendment cancels claims 2-37. However, there were only claim 1-36. Therefore, it is assumed that Applicant's intent was to cancel claims 2-36. Claim 1 remains for consideration.

#### **Double Patenting**

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
4. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
5. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
6. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,101,324. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined claim is not

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patentably distinct from the reference claim because the examined claim is ***anticipated*** by the reference claim. See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ 2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

**Allowable Subject Matter**

7. Claim 1 is allowable over the prior art of record and will be allowed once all outstanding rejections are traversed.

8. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art appears to be Carlucci et al.. Carlucci et al. disclose a method and system for generating icon displays representing digitized film scenes and scene processing operations, and manipulating the icon displays to initiate selected processing operations (such as transfers from one storage location to another) on the scenes. The invention can be embodied in a film scanning system having circuitry for digitizing scanned film images, for digitally correcting the digitized scanned images, and for inserting video sync information into the corrected images to convert the corrected images into a video signal. The system is also capable of inserting digital data in such a video signal, such as film in and out points, and data identifying a video storage location, and then storing the resulting video signal as a video format scene. In addition to generating a

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scene from a sequence of digitized film frames and related digital data, the system of the invention generates an icon representing the scene by compressing a selected one of the frames in the sequence. In response to a user command for information regarding a scene, the system displays the compressed scene image and other relevant scene data. The system also displays scene processing icons. In response to user selection of a scene icon and a scene processing icon, the system executes the corresponding processing operation on the corresponding scene.

9. However, Carlucci et al. does not disclose the ***means for*** disclosure of displaying, allowing, activating, de-selecting and de-activating, as disclosed in the specification. Thus, the claim is deemed novel and non-obvious over the prior art of record.

**10. Any inquiry concerning this communication or earlier communications from the examiner should be:**

**directed to:** Dr. Hugh Jones telephone number (703) 305-0023, Monday-Thursday 0830 to 0700 ET, **or** the examiner's supervisor, Kevin Teska, telephone number (703) 305-9704. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

**mailed to:** Commissioner of Patents and Trademarks

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Washington, D.C. 20231

**or faxed to:** (703) 308-9051 (for formal communications intended for entry) **or**

(703) 308-1396 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT").

Dr. Hugh Jones

Primary Patent Examiner

September 6, 2004

  
HUGH JONES Ph.D.  
PRIMARY PATENT EXAMINER  
TECHNOLOGY CENTER 2100